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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,599	05/04/2005	Luis Carlos Sernan-Dez Arppe	P/189-375	7504

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OSTROLENK FABER GERB & SOFFEN  
1180 AVENUE OF THE AMERICAS  
NEW YORK, NY 100368403

EXAMINER
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KARIKARI, KWASI

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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09/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/526,599	<b>Applicant(s)</b> SERNAN-DEZ ARPPE ET AL.	
	<b>Examiner</b> Kwasi Karikari	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claimed limitations "wherein the short message is sent based on the determined identity of the home mobile telephony network", in claims 1 and 11 are not clearly described in the specification as originally filed and this constitute new matter. For examination purposes, the Examiner would interpret the rejected claimed limitations in the broadest scope of the Applicant's invention. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-23 are rejected under U.S.C. 103(a) as being unpatentable over Gibson et al. (U.S. 6,775,249), (hereinafter Gibson) in view of Raviv et al., (U.S. 20020164983 A1), (hereinafter Raviv) and further in view of Pirkola et al., (U.S. 6,611,516), (hereinafter Pirkola).**

**Regarding claims 1 and 11,** Gibson discloses a dialing error notification system (= local, regional, national and international network including fax and voice messaging facilities GIRAFF 220 and DISC 130 which operate to inform customer of a dialing error has occurred, see col. 4, lines 6-45 and Fig. 1) for telephony network (users at a particular area make particular dialing errors, see col. 9, lines 1-12), the dialing error notification system comprising:

a first node (= apparatus 200 and GIRAFF 220; and monitoring of call to determine whether a valid destination has been specified, see col. 6, lines 14-63) of the telephony network comprising means apparatus for analyzing a number dialed by a subscriber and determining whether said dialed number complies with at least one predetermined error criterion (= GIRAFF analyzes dialing error, see col. 6, lines 14-63);

a first apparatus for determining the identity of the home mobile telephony network based subscriber (= DISC 130 receives international traffic; and the CLI capture facility operates to identify the identity of the number dialed by terminal 100, see col. 4,

lines 45-58; whereby CLI is any information that accompanies an incoming call, e.g., the calling terminal's phone number), and

a second apparatus for sending a message (=sending of fax message to terminal 100, see col. 5, lines 21-27) with a dialing error notification to the subscriber if said dialed number complies with at least one predetermined error criterion (= international access code or country code is incorrect; and announcement informing customer that error has occurred, see col. 4, lines 33-45; col. 6, line 14- col. 7, line 53 and Fig. 4, steps 425 and 435); wherein the message is sent based on the determined identity of the home mobile telephony network (= the CLI capture facility operates to identify the identity of the number dialed by terminal 100; and sending of fax message to terminal 100, see col. 4, lines 45-58; col. 5, lines 21-27; whereby CLI is any information that accompanies an incoming call, e.g., the calling terminal's phone number); but fails specifically to teach that the terminal 100 is "a visited subscriber" in a "visited network"; the sent fax message to the terminal 100 is "short message"; and the identity of the terminal 100 is based on the International Mobile Subscriber Identity of the visiting subscriber.

Raviv teaches a visited subscriber (WAP phone 210), a visited network (= VPLMN, see Pars. [0274-76]); short message service (see Pars. [0243, 0290-92] and Figs. 1 & 2) and MSISDN; see Par. [0245]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Raviv into the system of Gibson for the benefit of achieving a system that provides short message service in a visited mobile network.

The combination of Gibson and Raviv discloses an identification information (e.g., CLI and MSISDN) of terminal device in a visiting communication network but fails specifically to mention that such identification information includes International Mobile Subscriber Identity, IMSI.

Pirkola discloses a roaming communication system that mobile terminal is identify and associated to network by identification information such MSISDN and IMSI (see col. 4, lines 10-33 and Fig. 11).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Pirkola into the system of Gibson and Raviv for the benefit of achieving a system that include dynamic mapping of subscriber identification; an allows subscribers to roam between an IP-telephony network and cellular network (see col. 1, lines 19-24 and col. 4, lines 10-33).

**Regarding claims 2 and 12**, as recited in claims 1 and 11, Raviv teaches that the said first node is a Service Control Point of the visited mobile telephony network (see Pars. [0007-8]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Raviv into the system of Gibson and Pirkola for the benefit of achieving a system that provides short message service in a visited mobile network.

**Regarding claims 3 and 16**, as recited in claims 1 and 11, Raviv teaches a third apparatus for sending a message (M1) to an SS7-IP gateway from the first node, said

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message (M1) being a message with instructions to send the short message; a fourth apparatus for sending an http message to a short message sending server from said SS7-IP gateway, said http message being a message with instructions to send the short message; the second apparatus for sending the short message addressed to the visiting subscriber to a Short Message Service Centre of the visited network from said short message sending server upon receipt of said instructions by said short message sending server (see Pars. [0007-8, 0243, 0290-92] and Figs. 1 & 2).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Raviv into the system of Gibson and Pirkola for the benefit of achieving a system that provides short message service in a visited mobile network.

Regarding **claims 4 and 17**, as recited in claims 1 and 11, Raviv teaches that the system/method is comprising apparatus for selecting text for the short message (see Pars. [0243, 0290-92]

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Raviv into the system of Gibson and Pirkola for the benefit of achieving a system that provides short message service in a visited mobile network.

Regarding **claims 5 and 18**, as recited in claims 3 and 16, Raviv teaches that the system is comprising the short message sending server includes a database with short message texts and an indicator code included in the http message received from the SS7-IP gateway (see Pars. [0007-8, 0243, 0290-92] and Figs. 1 & 2).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Raviv into the system of Gibson and Pirkola for the benefit of achieving a system that provides short message service in a visited mobile network.

Regarding **claims 6 and 19**, according to claims 3 and 16, Raviv teaches a data service such short message service (see Pars. [0007-8, 0243, 0290-92] and Figs. 1 & 2).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Raviv into the system of Gibson and Pirkola for the benefit of achieving a system that provides short message service in a visited mobile network.

**Regarding claims 7 and 20**, as recited in claims 1 and 11, Pirkola discloses that the system/method further comprising a fifth apparatus for sending an initial control set-up message to the first node, the initial control set-up message comprising at least the following data: the telephone number dialed by the visiting subscriber the mobile telephone number of the visiting subscriber and the International Mobile Subscriber Identity of the visiting subscriber (see col. 4, lines 10-33 and Figs. 6 and 11).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Pirkola into the system of Gibson and Raviv for the benefit of achieving a system that include dynamic mapping of subscriber identification; an allows subscribers to roam between an IP-telephony network and cellular network (see col. 1, lines 19-24 and col. 4, lines 10-33).



**Regarding claims 8 and 21**, as recited in claims 1 and 11, Gibson further teaches the apparatus for sending an initial control set-up message to the first node is comprised in the Mobile Switching Centre of the telephony network, such that when a subscriber in a cell corresponding to the Mobile Switching Centre dials a telephone number, said Mobile Switching Centre sends the initial control set-up message to the first node (receiving dialed number at Switching Center, see step 400 and Fig. 4a).

**Regarding claims 9 and 22**, as recited in claims 1 and 11, Gibson further teaches a control apparatus for preventing a message (a fax has been sent within the previous predetermined period, see col. 10, lines 16-25) with a dialing error notification from being sent to a subscriber if the time elapsed since a first message with a dialing error notification was sent to said subscriber is less than a predetermined minimum time (see col. 9, line 64- col. 10, lines 35).

**Regarding claims 10 and 23**, as recited in claims 1 and 11, Gibson further teaches, wherein the error criteria include at least criterion selected from a group consisting of the following criteria:

- the number dialed begins with "+" followed by a sign different from a figure C,  $1/C \times 9$ ;
  - the number dialed begins with "00" followed by a sign different from a C,  $1 < C / 9$ ;
- the number dialed is in a 9- digit number beginning with a figure which is not 6, 7, 8 or 9,
- the number dialed begins with "+" or "00." followed by a country code followed by an

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escape code not applicable for international dialing to said country; and

- the number dialed is a number with fewer than 9 digits which is not a short code (error may occur because some countries may have error in regional code or insufficient digitals in the number dialed, see col. 10, lines 59-62).

**Regarding claim 13**, as recited claim 11, Gibson further teaches, based on the identity home mobile telephony network of the subscriber as determined by the International Mobile Subscriber Identity of the subscriber, it is determined whether the subscriber has the right to a dialing error notification service (an inherent feature of services provided in Fig. 1, because checking whether a subscriber is entitled to receive a service prior to offering the service is common procedure in telecommunication network).

**Regarding claim 14**, as recited in claim 13, Gibson further teaching of system of GIRAFF and DISC 130 (see col.7, lines 44-61), meets the limitations of claim 14.

**Regarding claim 15**, as recited in claim 14, Gibson further teaching of system of GIRAFF and DISC 130 (see col.7, lines 44-61), meets the limitations of claim 15.

4. **Claim 24 is rejected under U.S.C. 103(a) as being unpatentable over Gibson in view of Raviv and further in view of Pirkola and further in view of Lohtia et al., (U.S. 20030211845 A1).**

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**Regarding claim 24**, according to claims 3 and 16, as the combination of Gibson and Raviv fails to teach that the method is only carried out for visiting subscribers who are not provided with CAMEL service O-CSI flag.

Lohtia teaches a GSM CAMEL messaging application (see Par. [0034]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Lohtia into the system of Gibson, Raviv and Pirkola for the benefit of achieving a system that includes SMS server to facilitate transmission of information to user device.

### ***Conclusion***

5. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

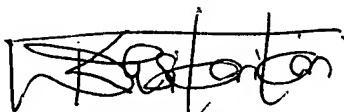
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Rafael Pérez-Gutiérrez* can be reached on 571-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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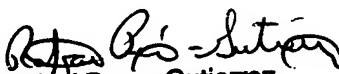
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Kwasi Karikari  
Patent Examiner  
09/13/2007



Rafael Perez-Gutierrez  
Supervisory Patent Examiner  
Technology Center 2600  
Art Unit 2617

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